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REMARKS

In response to the Office Action mailed on April 6, 2006, Applicants respectfully requests reconsideration. Claims 1, 3-18, 21,23-38, and 41-44 are now pending in this Application. In this Amendment, claims 43 and 44 have been added. A version of the claims containing markings to show the changes made is included hereinabove. Applicants believe that the claims as presented are in condition for allowance. A notice to this affect is respectfully requested.

Preliminary Matters

The Examiner issued a Final Rejection on April 6, 2006, which Applicants respectfully suggest is inappropriate at this time. MPEP §706.07(a) states " .. second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement ...". Applicants respectfully submit that, with respect to the pending claims at the time, the amendment submitted on February 23, 2006 did not amend the pending claims. Accordingly, the Examiner's new grounds of rejection submitted in the rejection of April 6, 2006 was not necessitated by Applicants amendment, nor by the submittal of an IDS, and therefore the rejection of April 6, 2006 should not have been a final rejection. Applicants request that the finality of the rejection of April 6, 2006 be withdrawn.

Claims 1, 3-18, 21, 23-38 and 41-42 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication Number 2001/0042201 to Yamaguchi et al (hereinafter Yamaguchi) in view of U.S. Patent No. 6,292, 839 to Naudus et al. (hereinafter Naudus). Yamaguchi relates to a security method and system wherein a type of security to be applied is determined by analyzing a received packet. Naudus discloses a method and system for reflexive tunneling using hidden virtual tunnels.

The Examiner stated that Yamaguchi discloses detecting an initial request at a beginning tunneling device and identifying the initial request as a candidate to be

converted to a tunneling request. A careful review of Yamaguchi fails to disclose or suggest a tunneling device or identifying the request as a candidate to be converted to a tunneling request. Yamaguchi discloses determining whether to perform IPSEC for a given packet, however IPSEC is not a tunneling request, therefore identifying a packet as a packet requiring IPSEC security does not correspond to identifying the request as a candidate to be converted to a tunneling request as an IPSEC association can be established without a tunnel being involved. Naudus also fails to disclose or suggest identifying the request as a candidate to be converted to a tunneling request.

Since claim 1 recites a beginning tunneling device and further recites identifying an initial request as a candidate to be converted to a tunneling request, while Yamaguchi and Naudus fail to disclose or suggest the same, Claim 1 is believed allowable over Yamaguchi and Naudus.

Further, applicants submit that the combination of Yamaguchi and Naudus is improper. It is well established that in order to combine references there must be some "suggestion of desirability of the combination". In re Noznik, Tatter and Oberhauf, USPQ 43 (CCPA 1973). Additionally the test of obviousness is not whether the prior art can be modified to produce the claimed invention, since under such a test all inventions would be obvious. Panduit Corp. v. Dennison Manufacturing Co., 810 F.2d 1561, 1574-75 (Fed. Cir. 1987). Further still, Yamaguchi and Naudus are in different class/subclass designations. Yamaguchi (security) is listed in class/subclass H04L 12/22 and Naudus (tunneling) in class/subclass G06F 13/00. The Patent Office itself has designated the references in different class/subclasses, further indicating that the references are different and should not be combined. Naudus does not disclose or suggest security, while Yamaguchi does not disclose or suggest tunneling. One of reasonable skill in the art would not look to a security system (Yamaguchi) as a manner of converting an initial request to a tunneling request. For all the reasons stated above, the combination of Yamaguchi and Naudus is improper and the rejection should be removed.

Claims 12, 21 32, 41 and 42 contain similar language as claim 1 and are believed allowable for the same reasons as claim 1. Claims 3-11, 13-18, 23-31 and 33-

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8 depend from claims 1, 12, 21 or 32 and are believed allowable as they depend from a base claim which is believed allowable.

Claims 43 and 44 have been added. Support for these claims can be found in the specification at page 16, lines 23-27. Applicants submit that no new matter has been added.

In view of the above, the Examiner's rejections are believed to have been overcome, placing claims 1, 3-18, 21, 23-38, and 41-44 in condition for allowance, and reconsideration and allowance thereof is respectfully requested.

Applicants hereby petition for any extension of time which is required to maintain the pendency of this case. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-3735.

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If the enclosed papers or fees are considered incomplete, the Patent Office is respectfully requested to contact the undersigned collect at (508) 616-9660, in Westborough, Massachusetts.

Respectfully submitted,



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